

## **REMARKS**

Claims 1-27 were filed on September 22, 2003. A first Office Action was mailed on June 28, 2005. Applicant mailed its Response "A" under 37 C.F.R. §1.111 on November 22, 2005.

A second Office Action was mailed on February 10, 2006, wherein the Examiner rejected Claims 1, 15 and 20 under 35 USC §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner also rejected Claims 1-9, and 15-18 under 35 USC §102(e) as being anticipated by the European Reference No. EP 1 245 476 A1, to Mertz ("the Mertz '476 Reference"). Claims 1-4, 6, 8, 10, 12, and 15-19 were rejected under 35 USC §103(a) as being unpatentable over French Reference FR 2678867 A1, to Jeanson ("the Jeanson '867 Reference") in view of Applicant's admitted prior art ("AAPA"). Claims 10-14 and 19 were rejected under 35 USC §103(a) as being unpatentable over the Mertz '476 Reference in view of AAPA or the Jeanson '867 Reference. Claims 20-26 were rejected under 35 USC §103(a) as being unpatentable over the Mertz '476 Reference in view of U.S. Patent No. 6,398,236 B1, to Richardson ("the Richardson '236 Patent"). Claim 27 was rejected under 35 USC §103(a) as being unpatentable over the Mertz '476 Reference in view of the Richardson '236 Patent as applied to Claim 23, and further in view of AAPA or the Jeanson '867 Reference.

Applicant has considered the Office Action and has amended the Claims. Specifically, Claims 1-27 have been cancelled. Claims 28-51 have been newly added. As set forth below, this reformatting of the claims is intended to advance the prosecution of this application by addressing the Examiner's rejections under 35 U.S.C. §112. Additionally in order to fully respond to the Office Action, Applicant will address all of the Examiner's cited prior art with respect to each of the newly added Claims 28-51. Based upon these amendments and the

following remarks, Applicant respectfully submits that the Claims remaining in the application, *ie.* Claims 28-51, are in condition for allowance.

#### CLAIM REJECTIONS UNDER 35 U.S.C. §112.

The Examiner has rejected independent Claims 1, 15, and 20 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. More particularly, the Examiner rejected Claims 1, 15, and 20 for including a Markush-type group whose alternatives arguably were not part of the same art recognized class. In order to advance the prosecution of this application and in response to the 35 U.S.C. §112 rejections of the Examiner set forth above, Applicant has reformatted the claims in order to remove the Markush-type groupings such that:

New independent Claim 28 and dependent Claims 29-35 are directed to and find support in the 1<sup>st</sup> and 3<sup>rd</sup> embodiments of Applicant's invention;

New independent Claim 36 and dependent Claims 37-41 are directed to and find support in the 2<sup>nd</sup> embodiment of Applicant's invention; and

New independent Claim 42 and dependent Claims 43-51 are directed to and find support in the 4<sup>th</sup> and 6<sup>th</sup> embodiments of Applicant's invention.

Applicant has chosen to cancel any claims directed to the 5<sup>th</sup> embodiment of Applicant's invention, and at this time is not including any new claims directed to that embodiment.

As a result, Applicant believes that all of the Examiner's 35 U.S.C. §112 rejections have been overcome. Applicant submits that newly reformatted Claims 28-51 are now in condition for allowance.

CLAIM REJECTIONS UNDER 35 U.S.C. §102(e).

The Examiner rejected Claims 1-9, and 15-18 under 35 U.S.C. 102(e) as being anticipated by the Mertz '476 Reference. (As stated above, Applicant will address the Mertz '476 Reference with respect to each of the newly reformatted Claims 28-51.) The Mertz '476 Reference is an improper prior art reference with regard to Applicant's invention. More particularly, the Mertz '476 Reference was published on October 2, 2002, and as such, has an effective date of October 2, 2002. The 37 C.F.R. §1.131 Affidavit of Applicant along with the accompanying exhibits, attached hereto as Exhibit 1 and incorporated herein by reference, demonstrate that Applicant's invention was reduced to practice prior to the effective date of the Mertz '476 Reference. As a result, the Mertz '476 Reference is not a valid prior art reference and cannot serve as a basis for an anticipation rejection of Applicant's invention, or more specifically newly reformatted Claims 28-51.

CLAIM REJECTIONS UNDER 35 U.S.C. §103.

The Examiner also rejected Claims 1-4, 6, 8, 10, 12, and 15-19 under 35 USC §103(a) as being unpatentable over the Jeanson '867 Reference in view of AAPA. (As stated above, Applicant will consider this rejection with respect to each of the newly reformatted Claims 28-51.)

It is well settled that all words recited in a claim must be taught by the cited references for an obviousness determination to be valid. *In re Wilson*, 424 F.2d 1382 (C.C.P.A. 1970). The focus of the obviousness analysis is the differences between the prior art and the claimed invention. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459 (1966).

More particularly, the Examiner states that: "Jeanson teaches a vehicle having a front and rear end (inherently) and having at least one vehicle component requiring compressed air (suspension and brakes, see attached English language abstract.) Also taught is a generally cylindrically shaped vessel sealed by an endcap [(17) at each of two ends and secured at each of the two endcaps to a structure that is a vehicle hanger (23.) The hanger is secured to the main frame (6) of the vehicle (at 24.)" *See February 10, 2006, Office Action at ¶ 6. (For the convenience of the Examiner, a copy of the translation of the Jeanson '867 Reference is attached to this response as Exhibit "2.")*

Applicant's newly reformatted Claims 28-51 are not taught or suggested by the Jeanson '867 Reference.

Independent claims 28, 36, and 42 all include a vessel, with or without end caps, that is attached at each of its ends **by a pair of brackets** to the frame main members or to the main members and suspension assembly hangers. This intervening bracket structure between the vessel and the main members and suspension assembly hangers is important because, as noted in Applicant's specification and in Applicant's Response "A", submitted on November 22, 2005, the bracket, as an intervening structure, plays an important role in force transfer during vehicle operation, so that the vehicle frame, including the main members and the vessel, can withstand such forces.

See also the discussions on:

Page 7 at lines 25-29 relating to the second embodiment of the present invention;

Page 9 at lines 3-12 relating to the third embodiment of the present invention;

Page 9 at lines 21-25 relating to the fourth embodiment of the invention;

Page 10 at lines 11-14 and referring to all embodiments of the invention.

In contrast, the Jeanson '867 Reference does not teach or suggest the use of brackets, or any intervening structures, for attaching the air vessel to the main members or the suspension assembly hangers of a vehicle. Rather, the structure taught by the Jeanson '867 Reference is a vessel that is attached directly to a pair of suspension assembly hangers, **with no intervening structure**. Because neither the Jeanson '867 Reference nor AAPA teaches or suggests, in combination or alone, the use of brackets or any other intervening structures, to attach the air vessel to the frame main members or suspension assembly hangers, those references cannot serve as a basis for a 35 USC § 103, obviousness rejection.

Based on the foregoing, the Jeanson '867 Reference does not teach or suggest newly reformatted independent Claims 28, 36, and 42.

Because dependent claims 29-35, 37-41, and 43-51 all depend directly or indirectly from allowable claims 28, 36, and 42, they too are in condition for allowance.

The Examiner has also rejected: Claims 10-14 and 19 under 35 USC 103 (a) as being unpatentable over the Mertz '476 Patent in view of the AAPA or the Jeanson '867 Patent, Claims 20-26 under 35 USC §103(a) as being unpatentable over the Mertz '476 Patent in view of the Richardson '236 Patent, and Claim 27 under 35 USC §103(a) as being unpatentable over the Mertz '476 Patent in view of the Richardson '236 Patent as applied to Claim 23 above, and further in view of the AAPA or the Jeanson '867 Patent. As stated above, the Mertz '476 Patent is an improper prior art reference with respect to Applicants invention. (See argument *Supra*.) Therefore, as an improper prior art reference the Mertz '476 Patent cannot serve as a basis for an obviousness rejection of newly reformatted Claims 28-51.

Applicant was the first to recognize the advantages of having an air vessel also serve as a vehicle frame cross member, in combination with brackets, for efficiently and satisfactorily

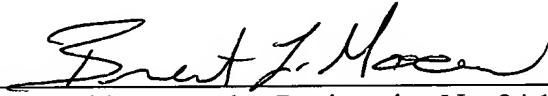
reacting loads that a vehicle encounters during vehicle operation. By combining the elements as Applicant has, a new and unexpected result has been achieved, that is, a frame structure that provides sufficient strength and durability for the loads encountered by a vehicle operating over the road, but also in reducing the weight and structural complexity of the vehicle by combining the functions of the compressed-air vessel and a frame cross member in a single structure.

The results produced by Applicant's invention have been long sought after by those skilled in the art, but until Applicant's invention the results have been unobtainable.

In view of the above, it is submitted that the Claims remaining in the application now are in condition for allowance and reconsideration of the rejections is respectfully requested.

Respectfully submitted,

BUCKINGHAM, DOOLITTLE & BURROUGHS, LLP

  
By: David P. Dureska, Registration No. 34,152  
Brent L. Moore, Registration No. 42,902

BLM/edf

4518 Fulton Drive, N.W.  
P. O. Box 35548  
Canton, OH 44735-5548  
Telephone: (330) 491-5289  
Facsimile: (330) 252-5454  
E-Mail: bmoore@bdblaw.com  
Attorney Docket No.: HEND-AV (45007-191)  
«CT2:492728\_v1»